

REMARKS

The Office Action mailed on November 25, 2008, considered and rejected claims 1-17. Claims 12-14 were rejected under 35 U.S.C. § 112, second paragraph as being indefinite. Claims 1-17 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Claims 1-3, 10 and 11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Inselberg* (U.S. Patent No. 6,760,595) in view of *Maskell* ("Distribution Resource Planning"), and further in view of *Wakai* (U.S. Patent No. 5,973,722). Claims 4 and 12-14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Inselberg*, *Maskell* and *Wakai* in view of Official Notice. Claims 5 and 7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Inselberg* in view of *Wakai*. Claims 6, 8, 9 and 15-17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Inselberg* and *Wakai* in view of Official Notice.

By this paper, claims 1, 4, 5, 10-12 and 14-16 have been amended, while no claims have been added or cancelled.¹ Accordingly, following this paper, claims 1-17 are pending, of which, claims 1, 5, 8, 10, 11 and 15 are the independent claims at issue.

As reflected above, the pending claims generally relate to methods for reserving and/or distributing self contained in-flight entertainment devices. As reflected in claim 1, for instance, a method includes accepting a reservation for rental of a self-contained in-flight entertainment device for use on a commercial airline flight of an aircraft. The reserved self-contained in-flight entertainment device is configured to present audiovisual presentations consisting of those loaded on the self-contained in-flight entertainment device prior to pickup by the one or more passengers. A reservation is added to a manifest containing at least a count of self-contained in-flight entertainment devices reserved for the commercial airline flight. The count is compared to a default number of available devices. When the count is larger than the default, more devices are brought on board based on the difference.

Claim 5 relates to reserving a self-contained in-flight entertainment device and receiving a voucher. The voucher is exchanged for the device. Upon return of the device, a return acknowledgement is received.

¹ Support for the claim amendments may be found within the Applicant's application as originally filed. All amendments are clearly supported at least by the disclosure in paragraphs 5-31 as numbered in the U.S. Patent Application Publication No. 2005/0055228, as well as in the originally filed claims and figures.

Claim 8 relates to reserving a self-contained in-flight entertainment device. When it is determined that content needs to be deleted, the devices with to-be-removed content are swapped with devices having updated content.

Claims 10 and 11 relate generally to the method of claim 1, including the reservation of a self-contained in-flight entertainment device, use of a manifest, and determining of when additional devices are needed. Claim 15 relates generally to claim 8.

Rejections under 35 U.S.C. § 112, second paragraph

As noted above, claims 12-14 were rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention. In particular, claims 12-14 were rejected for lacking antecedent basis for the phrase “pickup location.” As reflected above, claims 12 and 14 have been amended to clarify that “a” pickup location is for the reserved self-contained in-flight entertainment devices. Claim 13 depends from claim 12 such that antecedent basis of “the” pickup location is provided in claim 12. In view of at least the foregoing, Applicant respectfully submits that the rejections to claims 12-14 are overcome.

Rejections under 35 U.S.C. § 101

As also noted above, each of the claims was rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. More particularly, the Office states that the claims were rejected for being directed to methods that: (a) are not tied to another statutory class such (such as a particular apparatus); and (b) fail to transform underlying subject matter to a different state or thing. Applicant respectfully traverses.

In review of each of the pending claims, Applicant respectfully notes that each claim recites a self-contained in-flight entertainment device. For instance, in claims 1, 10 and 11 such devices are brought on board an aircraft or delivered to a pickup location. In claim 5, a voucher is exchanged for a self-contained in-flight entertainment device. In claims 8 and 15, when a self-contained in-flight entertainment device stored on an aircraft requires deletion of audiovisual presentations, other self-contained in-flight entertainment devices are delivered to the aircraft.

As is apparent from the foregoing, each of the pending claims recites use of a self-contained in-flight entertainment device. Method steps cannot, therefore, be performed without

such a device. Thus, the Office's comparison to a method of purely mental steps is clearly erroneous. It is simply impossible to use purely mental steps to conjure up and deliver or exchange a device in the manner recited in the pending claims. Indeed, further adding to the clear patentable nature of the pending claims, various claims recite that the recited devices are delivered to an aircraft, which is clearly also not merely a mental step.

Stated simply, the Office states that the method steps can be performed without the use of a particular apparatus; however, the methods cannot be performed without a self-contained in-flight entertainment device. A device is clearly a particular apparatus, thereby rendering the claims tied to a statutory class of inventions.

Rejections under 35 U.S.C. § 103

As noted above, each of the independent claims was rejected under 35 U.S.C. § 103(a) as being unpatentable over some combination of *Inselberg*, *Maskell*, *Wakai* and Official Notice. Applicant respectfully traverses.

A claim is unpatentable in view of 35 U.S.C. § 103(a) only if the claim would have been obvious to one of ordinary skill in the art at the time the invention was made. To make such a determination, the Office considers various basic factual inquiries as set forth in *Graham v. John Deere Co.* Such inquiries include:

- (A) Determining the scope and content of the prior art;
- (B) Ascertaining the differences between the claimed invention and the prior art; and
- (C) Resolving the level of ordinary skill in the pertinent art.

See *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, 82 USPQ2d 1385 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966); MPEP § 2141 *et seq.*

Significantly, in performing the second inquiry, the claimed invention and the prior art may not be considered on a piece-meal basis. Rather, in “determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983); MPEP § 2141.02. Consequently, the art must be considered in its entirety, even including “portions that

would lead away from the claimed invention.” *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983).

Inselberg relates to a method and apparatus for interactive audience participation at a live spectator event. More particularly, participating spectators employ wireless interactive devices with user input and output interfaces that present promotional messages. Spectators receive a question and enter their answers that are then transmitted to a central processor, while a display or user output interface displays the results to the spectators. (*Abstract*). In practice, an interactive device 10 is adapted to be used in an interactive audience participation system. (Col. 4, ll. 32-35). The device is enabled to communicate in a bi-directional manner with a wireless communication system at the live event, so as to provide information to a user and accept information provided by the user and transmit the same to the wireless communications system. (Col. 4, ll. 37-42). Audio and/or visual programming may be received by the interactive device using AM, FM, RF, VHF, UHF, or microwave frequency bands, optically through an infrared signal, through standard television broadcasts, using a connection to the Internet, or through cellular telephone systems such as FDMA, TDMA, CDMA, GSM. (Col. 4, ln. 60 to Fol. 5, ln. 19; Col. 6, ll. 7-57).

At a spectator event, multiple participants utilize the system with their respective devices. Specifically, the number of participants in the interactive system will vary from 50 to more than 100,000. (Col. 7, ll. 4-20). The system will transmit and receive wireless messages with the devices, and specifically will disseminate promotional messages to spectators through an out put interface. (Col. 7, ll. 25-30). Using such information, spectators are asked to respond with answers. The answers are transmitted to a central processor for processing into results. The results are accumulated—preferably in a server—and processed results are then announced to the spectators such as by being displayed on the user’s device. (Col. 7, ll. 31-52; Col. 9, ll. 8-22).

Information displayed on the interactive device may include advertisements for goods/services, queries and contests, and the like. Such information is stored in a transaction server and transmitted for output by the user interface. The user then enters information or orders items that are communicated to a provider for fulfillment. (Col. 9, ln. 22 to Col. 10, ln. 61).

Wakai relates to an in-flight passenger entertainment system. (*Abstract*). In particular, the entertainments ystem is coupled to an aircraft’s existing systems and the headend system are

coupled to a network switch for routing of data within the network. (*Id.*). The headend uses a data server media controller, media servers, interface units, manager units, and an attendant control panel. (Col. 4, ll. 25-29). The communication system enabled by such components connects to existing systems such as an overhead audio/video system. (Col. 4, ll. 46-51). Audio and video content may also be provided at seat electronics units by storing the information and then delivering the information from the media servers. (Col. 4, ll. 53-57). Specifically, audio/video content data is transmitted from the media servers over the network and to the appropriate bridge—and from there to the requesting media unit—***when requested by a passenger***. (Col. 4, ll. 55-62). Such transmission is controlled by the media controller of the headend system. (Col. 4, ll. 58-60).

Maskell relates to a distribution resource planning (DRP) system. In the system, products that have low levels of inventory at one location can be identified. Items located at other locations may then be transferred to the lower inventory location to meet customer demand. (p. 3).

Notably, none of the cited references appear to relate in any way to a self-contained in-flight entertainment device, particularly not one that may be reserved for rental by a passenger. More particularly, the cited *Maskell* reference has no relation to entertainment systems and the reason the same would even be considered analogous art is unclear as it is not addressed. The *Inselberg* and *Wakai* references further relate to media systems in differing environments and for different purposes. Nevertheless, the similarities of both systems are that they are dependent on headend or processing servers. As specifically noted in both references, information is transmitted to the media device during operation, and from a server unit. This is particularly notable inasmuch as various pending claims recite that audiovisual presentations for presentation by self-contained in-flight entertainment devices ***consists*** of content previously loaded on the device prior to pickup by the one or more passengers. The *Inselberg* and *Wakai* references, in direct contrast, provide content to a device in a real-time manner, including “when requested by a passenger.”

Accordingly, when considered in their entireties, the cited art relates to distributed systems—rather than self-contained systems. Further, such systems retrieve and present information obtained from a remote source after being acquired and used by a user. Thus, the combination of *Inselberg*, *Maskell* and *Wakai* references, when combined, not only fail to

disclose, suggest, or reasonably support a reserved self-contained in-flight entertainment device that has only presentations loaded prior to pickup, but actually teaches the exact opposite and contradicts the pending claims. Further, modifying the cited references to read on the pending claims would not only eliminate essential components for operation (such as headend and realtime processing components) to change the entire principle of operation of the references, but it would also render the devices unsuitable for their intended use.

Consequently, Applicant respectfully submits that at least claims 1, 5, 10 and 11, as well as all claims depending therefrom, are allowable over the art of record.

Independent Claims Rejected Using Official Notice

As noted in the M.P.E.P., the Office may take official notice when “the *facts* asserted to be well-known, or to be common knowledge in the art are capable of instance and unquestionable demonstration as being well-known.” (M.P.E.P. § 2144.03). Indeed, such *facts* must be “capable of such instant and unquestionable demonstration as to defy dispute.” (*In re Ahlert*, 424 F.2d, 1088, 1091, 165 USPQA 418, 420 (CCPA 1970)).

In rejecting claims 8 and 15, the Office used Official Notice to supply the gaps in the cited references, as acknowledged by the Office. (*See* Office Action, pp. 15, 18). More particularly, the Office takes official notice that: “it would have been obvious to one having ordinary skill in the art to exchange the newly offered IFE devices with IFE devices already stored on the plane which may be obsolete or having contained outdated equipment.” (Office Action, p. 15).

It should be noted that obviousness is recognized as a “legal conclusion” based on underlying factual inquiries. (M.P.E.P. § 2141). Inasmuch as official notice may only be taken of “facts,” the Official Notice was clearly improper as it purports to take official notice of the legal determination rather than the facts themselves. Indeed, the only fact purported to be utilized is that it is well-known for unnecessary weight to be removed from a plane for safety issues or due to fuel consumption issues. (Office Action, pp. 15, 16). Notably, however, such a fact cannot support the elements acknowledged by the Office as being absent from the cited references. More specifically, the Office recognizes that the cited art fails to disclose “*delivering a quantity of the other self-contained in-flight entertainment devices* having the other audiovisual presentations stored to the aircraft *for exchange with the any number of self-*

contained in-flight entertainment devices requiring deletion of stored audiovisual presentations.” (Office Action, p. 15).

The claims therefore do not expressly recite that entertainment devices are removed, but that additional entertainment devices are received. In other words, more devices are added such that the weight would be increased. Even if the claims do require that other devices be removed, they are **exchanged**. It’s difficult to understand how removing one device and adding another in its place saves weight. Accordingly, the factual premise used by the Office as providing a reason to modify the art does not even provide the benefit cited. Additional devices are added so that no weight savings are necessarily provided. Furthermore, as content in *Inselberg* and *Wakai* is stored remotely, on headend media servers, it is unclear why any entertainment device itself would be removed as the content can be updated on the headend without any change at all to the entertainment device itself.

Review of Other Official Notice Taken

In addition to official notice taken with respect to independent claims 8 and 15, the Office took official notice with respect to additional claims. Such official notice is hereby traversed.

For instance, with respect to claims 4 and 9, the Office took official notice that “there are various methods of delivering items.” (Office Action, pp. 10, 16) Applicant notes that even if true, such official notice is insufficient as a matter of law. Obviousness is judged at the time of the invention. Use of the word “are” indicates the present rather than the past. The Office Action, was dated well after the application was filed. Accordingly, that there “are” multiple manners of delivery is entirely irrelevant to an inquiry that must be determined at the date of invention. Indeed, using what is currently known is the epitome of hindsight, which is expressly disallowed in an obviousness inquiry.

Conclusion

In view of the foregoing, Applicant respectfully submits that the other rejections to the claims are now moot and do not, therefore, need to be addressed individually at this time. Similarly, all newly added claims are dependent on those claims specifically addressed and are therefore allowable over the art of record for at least the same reasons. It will be appreciated that Applicant does not acquiesce to any of the purported teachings or assertions made in the last

action regarding the cited art or the pending application, including any Official Notice. Instead, Applicant reserves the right to challenge any of the purported teachings or assertions made in the last action at any appropriate time in the future, should the need arise. Furthermore, to the extent that the Examiner has relied on any Official Notice, explicitly or implicitly, Applicant specifically requests that the Examiner provide references supporting the teachings officially noticed, as well as the required reason why one skilled in the art would have, at the time the invention was made, modified the cited art in the manner officially noticed.

Applicant further notes that the various claim amendments presented herein have been made without regard to the rejections supplied by the Office. In particular, various amendments to claims 1, 10, 11 and 15 have been amended for semantic purposes. Moreover, inasmuch as at least the rejection of claims 8 and 15 are clearly erroneous, Applicant respectfully submits that any subsequent action must be made non-final as any revised action should necessarily rely on arguments or art not necessitated by this amendment.

In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney at (801) 415-3000

Dated this 27th day of July, 2011.

Respectfully submitted,

/Colby C. Nuttall, Reg. No. 58,146/

COLBY C. NUTTALL
Registration No. 58,146
Attorney for Applicant
Customer No. 095261